

Application No. 09/841,255

AMENDMENT TO THE DRAWINGS

Applicants have corrected Fig. 1 to change reference number 131 to 132. Applicants have attached a marked up and an unmarked version of the corrected figure.

Application No. 09/841,255

REMARKS

Claim 1-3, 6-9, 12-15 and 23-31 remain for consideration. Claims 4 and 10 have been canceled without prejudice. Claims 1, 6, 8, 15 and 25 have been amended. Specifically, claims 6 and 25 have been amended to be independent claims. Claims 1 and 15 have been amended to insert a portion of the elements of claim 4, which has correspondingly now been canceled. Claim 8 has been amended to include consistent terminology with the specification. No new matter has been introduced by the amendments.

Claims 10, 13 and 14 have been found free of the art. Claims 1-9, 12, 15 and 23-31 stand rejected. Applicants respectfully request reconsideration of the pending rejection.

Objection to the Drawings

The Examiner objected to the drawings under 37 C.F.R. 1.84(p)(5) based on two criteria. First, the examiner indicated that the drawings omitted a reference number "132" discussed in the specification at page 9, line 22. Second, the Examiner indicated that the drawings included a reference number "131" in Fig. 1 that was not described in the description. These related errors are corrected by the correction of the reference number on Fig. 1 by replacing "131" with "132." In view of the correction, Applicants respectfully request withdrawal of the objection to the drawings.

Rejection For Lack of Written Description

The Examiner rejected claim 8 under 35 U.S.C. § 112, first paragraph, for lack of written description. While Applicants strenuously but respectfully disagree with the rejection since a person of ordinary skill would clearly know the scope and meaning of the term "motorized polisher" which was in the claim as filed, Applicants have amended the claim as suggested by

Application No. 09/841,255

the Examiner. In view of the amendment of claim 8, Applicants respectfully request withdrawal of the rejection of claim 8 under 35 U.S.C. § 112, first paragraph, for lack of written description.

Rejection for Obviousness-Type Double Patenting Over 09/136,483

The Examiner provisionally rejected claims 15, 23, 24 and 25 under the judicial doctrine of obviousness-type double patenting over claims 9, 13 and 14 of copending Application No. 09/136,483. Applicants incorporate by reference their arguments on this issue from their Appeal Brief and Reply Brief. However, while Applicants maintain their position regarding the inappropriateness of this rejection, claim 15 has been amended. As amended, it is clear that claims 15, 23, 24 and 25 are not *prima facie* obvious over the claims of application 09/136,483 since the claimed compositions are not referenced in the claims of the '483 application. Thus, Applicants respectfully request withdrawal of the rejection of claims 15, 23, 24 and 25 under the judicial doctrine of obviousness-type double patenting over claims 9, 13 and 14 of copending Application No. 09/136,483.

Rejection for Obviousness-Type Double Patenting Over 09/433,202

The Examiner provisionally rejected claims 1, 4, 6, 15, 25, 26, 29 and 31 under the judicial doctrine of obviousness-type double patenting over claims 1, 3, 24 and 26 of copending Application No. 09/433,202. Applicants incorporate by reference corresponding arguments from their Appeal Brief of February 10, 2004 and their Reply Brief of May 17, 2004. Applicants maintain that the rejection for obviousness-type double patenting over a later filed application is not appropriate. Applicants note that practitioners do not generally file terminal disclaimers for earlier filed applications or patent when later filed improvement applications are filed. Yet, under the reasoning of the pending rejections, all of these earlier patents, which likely would be a majority of all unexpired issued patents, would be unenforceable until a terminal disclaimer is

Application No. 09/841,255

filed over later improvement patents since obviousness-type double patenting is not a doctrine that has limited application within Patent Office practice.

The Examiner further points to MPEP 804.02 VI., which discusses the Requirement of a Terminal Disclaimer for applications filed on or after June 8, 1995. Applicants note that this section of the MPEP is directed to issues relating to continuation, divisional or national phase applications under 35 U.S.C. §§ 120, 121 or 365(c). With all due respect, this section of the MPEP is not applicable to the present fact situation. The presence of this discussion relating to continuation and divisional applications tends to suggest that the present rejection is improper since the present applications are not related under 35 U.S.C. 120, 121 or 365(c). With respect to the comments from the Examiner of no evidence of record of administrative delay, Applicants note that the Examiner's invocation of patent term extension as a rationale for the obviousness-type double patenting relates to a clear statutory definition of administrative delay that results in the patent term extension. In view of the comments incorporated by reference and the further comments above, Applicants respectfully request withdrawal of the rejection of claims 1, 4, 6, 15, 25, 26, 29 and 31 under the judicial doctrine of obviousness-type double patenting over claims 1, 3, 24 and 26 of copending Application No. 09/433,202.

Rejection Over U.S. 4,842,837

The Examiner rejected claims 26, 29 and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,842,837 to Shimizu. Applicants incorporate by reference their arguments from their Appeal Brief of February 10, 2004 and their Reply Brief of May 17, 2004. With respect to the Examiner's arguments that monodispersed means uniform, Applicants' note that "uniform" is a term of degree. Almost everyone asserts that their particles are uniform or monodispersed. The issue is always where in the range of degrees do the materials actually fall. "Every element of the claimed invention must be literally present, arranged as in the claim. The

Application No. 09/841,255

identical invention must be shown in as complete detail as is contained in the patent claim." Richardson v. U.S. Suzuki Motor Corp., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(Internal citations omitted, and emphasis added.); see also MPEP 2131. "Here, as well, anticipation is not shown by a prior art disclosure which is only 'substantially the same' as the claimed invention." Jamesbury Corp. v. Litton Industrial Products, Inc., 225 USPQ 253, 256 (Fed. Cir. 1985)(emphasis added). Applicants maintain that the Examiner has fallen far short of establishing a case of *prima facie* anticipation under applicable legal standards. Thus, Applicants respectfully request withdrawal of the rejection of claims 26, 29 and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,842,837 to Shimizu.

Rejection Over U.S. 4,842,837, U.S. 5,318,927, U.S. 5,626,715 and U.S. 5,389,194

The Examiner rejected claims 27 and 28 under 35 U.S.C. § 103 as being unpatentable over Shimizu in view of U.S. 5,318,927 to Sandhu, U.S. Patent 5,626,715 to Rostoker et al. and U.S. Patent 5,389,194 to Rostoker. Applicants incorporate by reference their arguments from their Appeal Brief of February 10, 2004 and their Reply Brief of May 17, 2004. Again, Applicants note that a general statement on uniformity or on being monodispersed does not teach or suggest the degree of uniformity of Applicants' claimed invention. Applicants maintain that the Examiner has fallen far short of establishing *prima facie* obviousness. Applicants respectfully request withdrawal of the rejection of claims 27 and 28 under 35 U.S.C. § 103 as being unpatentable over Shimizu in view of U.S. 5,318,927 to Sandhu, U.S. Patent 5,626,715 to Rostoker et al. and U.S. Patent 5,389,194 to Rostoker.

Rejection Over U.S. 5,389,194 or U.S. 5,626,715

The Examiner rejected claims 1, 2, 6-9, 12, 15, 23, 25-27 and 29-31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,389,194 to Rostoker or under 35 U.S.C. § 102(e) as

Application No. 09/841,255

being anticipated by U.S. Patent 5,626,715 to Rostoker et al. Applicants incorporate by reference their arguments from their Appeal Brief of February 10, 2004 and their Reply Brief of May 17, 2004. Applicants maintain that the Examiner has failed to establish *prima facie* anticipation. Furthermore, Applicants discuss below the issues regarding the state of the art at the priority date of the present application. Applicants respectfully request reconsideration of the rejection based on the following comments.

"Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim." Richardson v. U.S. Suzuki Motor Corp., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(Internal citations omitted, and emphasis added.); see also MPEP 2131. "Here, as well, anticipation is not shown by a prior art disclosure which is only 'substantially the same' as the claimed invention." Jamesbury Corp. v. Litton Industrial Products, Inc., 225 USPQ 253, 256 (Fed. Cir. 1985)(emphasis added).

The Examiner is giving meaning to the terms in the Examples that are not found in the text. The prophetic examples of the Rostoker patents only give values for X, Y or Q, and Z. The Rostoker patents clearly do not say in any way that all of their particles are within a certain cutoff value.

Dr. Singh could not make full sense of the discussion in the Rostoker patents as indicated in Dr. Singh's Declaration. Examiner's unsupported statements cannot refute an expert. The Examiner has not presented any documentary evidence of any kind that lends support to any interpretation of the language in the Rostoker patents. With all due respect, it is hard to keep track of the various PTO interpretations of the terminology of the Rostoker patent since besides the position of the present Examiner, the Examiner of 09/136,483 had an interpretation, the Board of Appeals for that case provided yet another interpretation and the Solicitor gave yet another interpretation during the Appeal to the Federal Circuit. If the meaning is clear, it is not

Application No. 09/841,255

clear to the undersigned why so many versions of the PTO position have propagated, and yet not one single piece of external evidence to shed light on the morass.

With respect to the enablement of Rostoker patents, the patents only refers to the methods of the 5,128,081 to Siegel et al. The Examiner references vague statements in the Rostoker patents regarding gamma alumina and colloidal silica. However, it is not clear that these materials are necessarily made by an approach other than the Siegel method or if other approaches are contemplated. Regardless, none of this rises to the level of an enabling disclosure of Applicants' claimed invention. Applicants respectfully submit the Declaration of Dr. Kambe in this application, which is a copy of a declaration submitted in copending case 09/136,483 referenced by the Examiner. This Declaration shifts any burden on the enablement issue back to the PTO. If these materials were well known in the art using other approaches, the PTO should be able to point to these disclosures. This has not been done, even though it is the Patent Offices' burden.

Based on an additional several years of experience in the Nanotechnology field, some early work relating to titanium dioxide has come to light. These references are submitted in an Information Disclosure Statement mailed on the same day as the filing of this Amendment. The newly disclosed references teach solution based approaches for forming extremely uniform titanium oxide particles down to average particle sizes below 50 nm. Applicants note that claims 1 and 15 as amended do not refer to titanium dioxide. Furthermore, these references are directed to the UV absorbing abilities and transparency to visible light of the titanium dioxide particles. These references do not suggest use for polishing a substrate surface. Thus, there would be no motivation to combine these references with references related to polishing.

Applicants respectfully assert that the Examiner has failed to establish *prima facie* anticipation, and to the extent that *prima facie* anticipation has been established, this has been rebutted. Applicants respectfully request withdrawal of the rejection of claims 1, 2, 6-9, 12, 15,

Application No. 09/841,255

23, 25-27 and 29-31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,389,194 to Rostoker or under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,626,715 to Rostoker et al.

Rejection Over U.S. 5,389,194 or U.S. 5,626,715 in View of U.S. 5,318,927

The Examiner rejected claims 3, 24 and 28 under 35 U.S.C. § 103(a) as being unpatentable over U. S. 5,389,194 to Rostoker or U.S. 5,626,715 to Rostoker et al. in view of U.S. 5,318,927 to Sandhu. Applicants incorporate by reference their arguments from their Appeal Brief of February 10, 2004 and their Reply Brief of May 17, 2004. Furthermore, Applicants have discussed the issue further above relating to the Rostoker patents. Applicants maintain that the Examiner has failed to establish *prima facie* obviousness of the claimed subject matter, and to the extent that *prima facie* obviousness has been established, that it has been rebutted. Applicants respectfully request withdrawal of the rejection of claims 3, 24 and 28 under 35 U.S.C. § 103(a) as being unpatentable over U. S. 5,389,194 to Rostoker or U.S. 5,626,715 to Rostoker et al. in view of U.S. 5,318,927 to Sandhu. Although Applicants do not acquiesce in the assertions in the Office Action relating to the specific features of the dependent claims, Applicants do not comment further on these since they are presently moot in view of the above comments.

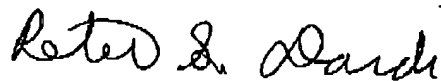
Application No. 09/841,255

CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Peter S. Dardi, Ph.D.
Registration No. 39,650

Customer No. 62274
U.S. Bank Plaza, Suite 2000
220 South Sixth Street
Minneapolis, Minnesota 55402
Telephone: (404) 949-5730

Annotated Sheet

1/3

